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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,423	07/19/2001	Craig Novak	394-137	7272

7590 06/15/2004
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EXAMINER

STERLING, AMY JO

ART UNIT PAPER NUMBER

3632

DATE MAILED: 06/15/2004

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20040603

Application Number: 09/909,423
Filing Date: July 19, 2001
Appellant(s): NOVAK ET AL.

GERARD F. DUNNE
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 2, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 17, 18 and 20 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Claims under Appeal

Group 1: 17

Group 2: 18

Group 3: 20

Claims not under Appeal

Claims 1-3, 8, 9 and 14 have been allowed.

Claims 4-7, 10-13, 15, 16 and 21 have been cancelled.

Claims 19 and 22-24 have been objected to as containing allowable subject matter.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,441,348	VALENTINO	8-1995
4,930,903	MAHONEY	6-1990
5,016,848	METZ	5-1991

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

Claim 17 stands rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 5441348 to Valentino.

The patent to Valentino discloses a decorative bag means having a core (16) formed of a weighty material adapted to hold a plurality buoyant balloon in place and positioned within the decorative bag, the decorative bag means having decorative material (20) secured within the decorative bag via the core in a position to conceal the core from casual view, the bag holder which could be adapted to be displayed for retail sale and for having decorative appeal.

Claim Rejections - 35 USC § 103

Claim 18 stands rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5441348 to Valentino and in view of United States Patent No. 4930903 to Mahoney.

Valentino shows the basic inventive concept with the exception that it does not teach wherein the core is secured to the interior of the bag.

Mahoney shows a core (14, 48) which is secured to the inside of the interior of a decorative gift bag, used so that the core does not fall out of the bag when moved or

tipped. (See Col. 2, lines 46-50). Therefore, it would have been obvious to someone skilled in the art to have modified the core of Valentino to be secured to the bag, in order to make the device less likely to come apart upon moving or tipping the device.

Claim 20 stands rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5441348 to Valentino and in view of United States Patent No. 5016848 to Metz.

Valentino shows the basic inventive concept with the exception that it does not teach wherein the core has sidewalls generally trapezoidal in shape to taper towards the upper portion.

Metz shows a balloon holding device (10) which has a core (11, 12) for weighting the balloons to a desired surface, the core (11, 12) having a generally trapezoidal shape which tapers towards the upper portion, used so that more balloons could be attached to the device, if so desired or to add weight to the bag, so that it does is not easily moved while subjected to an outside force of some kind. Therefore, it would have been obvious to someone skilled in the art to have changed the shape of the core as taught by Valentino, in order to be able to hold the bag in the desired location while being subjected to an outside force.

Response to Arguments

The applicant has argued that the claim 17 is allowable because as amended the Valentino reference does not teach the limitations of the core being a mass of dense,

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weighty material providing sufficient weight to hold a plurality of buoyant balloons. (See Appeal Brief, page 6, lines 8-15).

This is unpersuasive because the term "dense" is a relative term, with a broad meaning, the definition which is dependent upon the reference system from which the comparison is made. For example, air, consisting of oxygen, hydrogen and nitrogen could be considered a dense mass, as compared to a mass of only hydrogen. Yet air, as compared to liquid water, would not be considered a dense mass at all, the density of each relying on the element of comparison. Therefore, the term "dense" which is claimed without a reference comparison, in the broadest sense, could be met by any material or device including the core (16) as taught by Valentino.

Also, the "weight sufficient to hold a plurality of buoyant balloons" has the same relative definition, the weight being dependent on the size of the balloons and the type and amount of gas used to fill them. The balloons which may have an unlimited variety of diameters, shapes and sizes, have an infinite weight range as currently defined by claim 17. The balloons may be filled entirely with helium or a mix of helium and air, providing yet another range in which the weight sufficient to hold the balloons may vary. Therefore, a cardboard core may be weighty enough to hold one or two large balloons or several smaller balloons, depending on the size and density of the cardboard and the size and density of the gas which inflates the balloon to make it buoyant. In addition, the term "buoyant" is also considered relative to the gas or liquid in which it floats, thereby making the term buoyant relative as well. Therefore the claim limitations are

easily met by Valentino, when interpreted in the broadest range of the terms used, the core (16) being dense enough to hold party balloons of a particular buoyancy.

The applicant has also argued that the “means” clauses in the claim should be interpreted as described by the specification and that the specification does not include a cardboard insert and therefore, it must be precluded, stating that party balloons are a well understood commodity. (See Appeal Brief, page 7, lines 4-9).

This is also unpersuasive in that party balloons, as stated above, may differ in size and shape and buoyancy and therefore have a broad range of what is sufficient to hold them and that a cardboard insert may be of sufficient weight to hold them in place.

The applicant has argued that the limitations of claim 18 are not met by Valentino and Mahoney because “the balloon holder of Valentino is displayed after retail sale (See Appeal Brief, page 7, lines 14-17) and that when the Valentino bag is displayed prior to retail sale, the decorative material is fan-folded in place and does not conceal the core from view.

This is unpersuasive for two reasons. First, the limitation is functional only, in that it depicts “how” the decorative bag is used. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Secondly, the applicant has assumed that the Valentino and Mahoney bag would not be completed until after the “display for retail sale”, however, the seller of such an item, inherently could display a completed Valentino in combination with the Mahoney bag as a demonstration, in order to sell such item. Therefore, the limitation is also met by Valentino and Mahoney by being inherent to the combined inventions. Based on the similarity of the structures recited that the functional limitations of the “retail sale display” may be an inherent characteristic of the balloon holder. In accordance with In re Best, 562 1252, 195 USPQ 430, 433 (CCPA 1977):

Where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

Accordingly, the burden is placed upon the applicant to prove that the functional limitation of having the decorative bag balloon holder to be placed on retail display, is not an inherent characteristic of the decorative bag taught by Valentino and Mahoney.

The applicant has also argued that the limitations of claim 20 are not met in that Valentino in view of Mahoney and Metz are non-analogous art because Valentino is to hold purchases in a store and Metz has a trapezoidal weight which holds balloons. (See Appeal Brief, page 9, lines 1-7).

This is unpersuasive because the combination of Valentino and Metz solves a reasonably pertinent problem to which the inventor was concerned. It is well known in the art that a gift bag may turn over when placed in certain environments that contain

wind or a fan. Adding weight to a bag in order to keep the bag from turning over in the wind is a well known solution to this well known problem. Also, attaching party balloons to a gift bag as is well known in the art and to add more weight to the bag as more balloons are added, in order to keep the bag in a desired location, is also a well known solution to a reasonably pertinent problem. Therefore, the Valentino and the Metz references could easily be combined and the non-analogous art argument is unpersuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge to combine extra weight to a gift bag to keep it steady in all kinds of unstable environments, such as a windy environment, was generally available to one of ordinary skill in the art at the time of the invention and the references clearly have a motivation to combine.

Therefore the arguments as presented by the applicant are unpersuasive and the rejections stand with regards to claims 17, 18 and 20.

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Conclusion

For the above reasons, it is believed that the rejections should be sustained and an
affirmance is respectfully requested.

Respectfully submitted,



Amy J. Sterling
June 3, 2004

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